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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,870	04/12/2001	Masad J. Damha	1770-206US FC	5859

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EXAMINER

EPFS FORD, JANET L

ART UNIT

PAPER NUMBER

1635

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/719,870

Applicant(s)

DAMHA ET AL.

Examiner

Janet L. Epps-Ford, Ph.D.

Art Unit

1635

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 24 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 06 December 2004. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 2-6, 19-20, and 31-34 would remain rejected for the reasons of record.  
Claim(s) withdrawn from consideration: 7-17.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

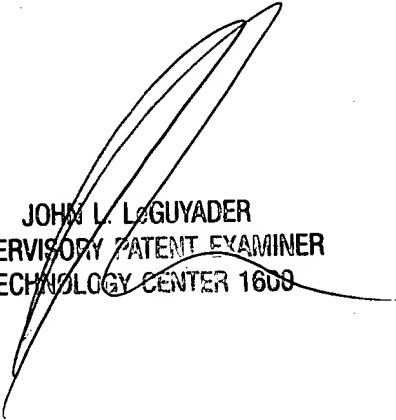
11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Janet L. Epps-Ford, Ph.D.  
Patent Examiner  
Art Unit: 1635

Continuation of 3. NOTE: Applicants have broadened the scope of claims 2-3, 5-6, and 19-20 to encompass wherein the claimed compositions or oligonucleotides selectively modulate gene expression in a sequence specific manner. Additionally Applicants have removed the chemical formula which limited the structure of the oligonucleotide consisting of B-arabinose sugars originally recited in the claims that were finally rejected. Applicant's new amendment requires a broader search, since the internucleoside linkages, nucleobases and the 4' position of the furanose ring of the B-arabinose sugars in the claimed oligonucleotides are no longer limited to those previously defined in the original chemical formula set forth in the claims. Additionally, Applicants have added additional 2' modifications of the claimed oligonucleotides, in particular Applicants have added wherein the 2' modification can be an alkylhalide or an alkylsulfhydryl group. These limitations were not previously search and/or considered by the Examiner. Moreover, since the instant claims now encompass oligonucleotides or compositions that "modulate," i.e. increase or decrease, gene expression in a sequence specific manner, a new search and consideration of the prior art is necessitated since the claims have not been considered for "modulation" and/or oligonucleotides which would increase expression.

The instant amendment also raises new issues under 37 CFR 1.121(c). Applicants have made amendments to claims 11, 15, and 17, without providing the appropriate markings indicating Applicant's amendment. Applicants replaced the term "hybridizing" in claim 15 with the term "hydridizing," the term is spelled incorrectly. It is noted that the term "hybridization" as set forth in original claim 11 and 17, was changed in the instant amendment to the term "hydribization," this term is also spelled incorrectly.

Continuation of 11. does NOT place the application in condition for allowance because: All of Applicant's arguments are directed to the claims as amended. Applicant's are relying on the amendment of the rejected claims to recite oligonucleotides comprising B-D-arabinose sugars comprising 2' modifications, to overcome the pending art rejections. As stated above, a new search and consideration of the prior art would be necessary to determine if the claims as amended would be free of the art.



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